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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,852

07/20/2006

Kiyotaka Kuzushima

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1872

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EXAMINER

YU, MISOOK

ART UNIT

PAPER NUMBER

1642

MAIL DATE

DELIVERY MODE

02/27/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<i>Office Action Summary</i>	Application No.	Applicant(s)	
	10/586,852	KUZUSHIMA, KIYOTAKA	
	Examiner	Art Unit	
	MISOOK YU	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2007.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-62 is/are pending in the application.
- 4a) Of the above claim(s) 9-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/05/08,09/19/06,07/20/06</u>                                | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of group I, claims 2-8 in the reply filed on 01/07/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 9-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 2-62 are pending and claims 2-8 are examined on merits.

### *Specification*

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code on page 13 line 22. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The disclosure is also objected because the amino acid sequences in Table 1 on page 36 do not have SEQ ID NO. 37 CFR 1.821 (d) states where the description or claims of a patent application discuss a sequence that is set forth in the "Sequence Listing" in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO:" in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application.

*Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. Claims 2-8 as currently construed do not show a hand of man. Inserting "isolated" or purified in front of "peptide" in claim 2 line 1 would obviate this rejection.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US 20030148463 A1 (Aug. 7, 2003).

Claims 2-8 are drawn to a peptide consisting essentially of SEQ ID NO: 1 and 2 and the intended use of the peptide in claims 3-5 is cancer vaccine and for a cytotoxic T lymphocyte inducer.

The following is a sequence comparison of the instant SEQ ID NO: 1 and the sequences in US 20030148463 A.

US-10-325-694-98

Query Match

100.0%; Score 49; DB 4; Length 13;

Art Unit: 1642

Best Local Similarity 100.0%; Pred. No. 0.032;  
Matches 9; Conservative 0; Mismatches 0; Indels 0; Gaps  
0;

Qy 1 RYQLDPKFI 9  
| | | | | | | |  
Db 5 RYQLDPKFI 13

US-10-325-694-99

Query Match 100.0%; Score 49; DB 4; Length 13;  
Best Local Similarity 100.0%; Pred. No. 0.032;  
Matches 9; Conservative 0; Mismatches 0; Indels 0; Gaps  
0;

Qy 1 RYQLDPKFI 9  
| | | | | | | |  
Db 3 RYQLDPKFI 11

The following is a sequence comparison of the instant SEQ ID NO: 2 and the  
sequences in US 20030148463 A.

US-10-325-694-137

Query Match 100.0%; Score 56; DB 4; Length 13;  
Best Local Similarity 100.0%; Pred. No. 0.008;  
Matches 10; Conservative 0; Mismatches 0; Indels 0; Gaps  
0;

Qy 1 YYVDEKAPEF 10  
| | | | | | | |  
Db 4 YYVDEKAPEF 13

US-10-325-694-138

Query Match 100.0%; Score 56; DB 4; Length 13;  
Best Local Similarity 100.0%; Pred. No. 0.008;  
Matches 10; Conservative 0; Mismatches 0; Indels 0; Gaps  
0;

Qy 1 YYVDEKAPEF 10  
| | | | | | | |  
Db 2 YYVDEKAPEF 11

Art Unit: 1642

Since the instant specification does not define the scope encompassed by the transitional phrase "consisting essentially of", it is interpreted as open transitional phrases, thus peptides taught by US20030148463 anticipates the claimed invention.

As for claims 3-8, according to MPEP 2111-2111.0, If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1642

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MISOOK YU  
Primary Examiner  
Art Unit 1642

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Primary Examiner, Art Unit 1642